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Please amend the paragraph on page 89, lines 7 to 13 as follows:

The present invention is not to be limited in scope by the exemplified embodiments which are intended as illustrations of single aspects of the invention. Indeed, various modifications of the invention in addition to those described herein will become apparent to those skilled in the art from the foregoing description. Such modifications are intended to fall within the scope of the appended claims.

In the Claims:

Please cancel claims 15, 21 and 23 without prejudice or disclaimer.

Remarks

Claims 15, 21 and 23 have been cancelled and claims 1 - 14, 16 - 20 and 22 are pending. The remaining claims have not been amended.

I. Objections

On page 3 of the Office Action, the Examiner alleges that claims 1 - 3, 6 - 8, 10 - 13, 15 and 20 - 23 are objected to as containing non-elected subject matter. Further, the Examiner has withdrawn claims 4, 5, 9, 14 and 16-19 because allegedly they are drawn to a non-elected invention.

In the response to the restriction requirement filed May 6, 2002, Applicants elected a species pursuant to 35 U.S.C. § 121. It seems that the Examiner has limited the scope of claim 1 to compounds wherein R^{3'} and R^{4'} for an un-substituted pyrrolidiny-1-yl group based on the species that was elected. Applicants assert that this is improper since the Examiner is not following the procedure set forth in MPEP § 803.02. MPEP § 803.02 prescribes that "[f]ollowing election, the Markush-type claim will be examined fully with respect to the elected species and *further to the extent necessary to determine patentability.*" (Emphasis added).

In the instant Office Action, it seems that the Examiner has not found prior art that would render the elected species either anticipated or obvious. Under such circumstances MPEP § 803.02 prescribes that "should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." The Examiner has clearly not extended the search beyond the elected species. Applicants respectfully urge that she extend the search beyond the elected species as prescribed by MPEP § 803.02. Applicants urge that the Examiner examine claims 4, 5, 9, 14 and 16-19 along with claims 1-3, 6-8, 10-13, 20 and 22, such that claims 1-14, 16-20 and 22 are pending.

II. Objections to the Specification

On page 3 of the Office Action, the Examiner has required correction to the table on page 88. Applicants have complied with this requirement by inserting the heading --Table 1 (continued)-- at line 1 of page 88.

The Examiner has also required corrections to the paragraph starting on line 7 of page 89. Applicants have complied with this requirement by deleting the phrase "any clones, DNA or amino acid sequences which are functionally equivalent are within the scope of the invention."

Withdrawal of the foregoing objections to the specification is respectfully requested.

III. The Provisional Statutory-type Double Patenting Rejection

On page 4 of the Office Action, the Examiner has issued a provisional statutory-type double patenting rejection of claims 6, 8, 15, 21 and 23 under 35 U.S.C. § 101 over claims 2, 4, 5, 7 and 9 of co-pending Application Serial No. 09/863,905.

Applicants assert that the provisional statutory-type double patenting rejection of claims 6, 8, 15, 21 and 23 under 35 U.S.C. § 101 over claims 2, 4, 5, 7 and 9 of co-pending Application Serial No. 09/863,905 is improper with respect to claims 6 and 8. The

Examiner is of the opinion that claims 6 and 8 are directed to the "same invention" as claims 2 and 4 of the '905 Application.

Applicants respectfully assert that while claims 6 and 8 of the instant application seem to overlap in scope with claims 2 and 4 of the '905 application, overlap in scope is not the proper test for "same invention." *In re Vogel* sets forth the test for "same invention." *In re Vogel*, 164 U.S.P.Q. 619 (CCPA 1970). *In re Vogel* sets forth that a "[g]ood test, and probable only objective test for 'same invention' in determining whether there is 'same invention' type of double patenting is whether one claim could be literally infringed without literally infringing [the] other." *In re Vogel* at 619. In the instant application, there are species that will literally infringe claims 6 and 8, but will not literally infringe claims 2 and 4 of the '905 application. If one considers, for example, claims 6 and 3 wherein R¹ and R⁷ are hydrogen (the limitations recited in claim 6) and wherein R³ and R⁴ are 2-hydroxymethylpyrrolidin-1-yl (one of the limitations recited in claim 3), one can see that such a species would literally infringe claim 6 of the instant Application, but would not literally infringe claim 2 of the '905 Application. Since one claim could be literally infringed without literally infringing the other, Applicants assert that there is no statutory-type double patenting with respect to claims 6 and 8 of the instant Application and claims 2 and 4 of the '905 Application.

The provisional statutory-type double patenting rejection of claims 15, 21 and 23 under 35 U.S.C. § 101 over claims 5, 7 and 9 of the '905 Application has been rendered moot based on the cancellation of those claims. Further, the provisional statutory-type double patenting rejection of claims 6 and 8 under 35 U.S.C. § 101 over claims 2 and 4 of the '905 has been overcome based on the foregoing arguments. Reconsideration and withdrawal of the rejection is respectfully requested.

IV. The Provisional Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

On page 5 of the Office Action, the Examiner has provisionally rejected claims 1 -3, 7, 10 - 13, 20 and 22 under the judicially created doctrine of obviousness-type double patenting over claims 1, 3, 6 and 8 of the '905 Application.

Applicants submit that upon completion of examination, Applicants will file a duly executed Terminal Disclaimer if necessary.

V. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

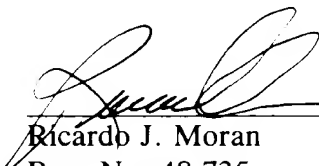
Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: August 21, 2002

By:


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Version with Markings to Show Changes Made

Specification:

The present invention is not to be limited in scope by the exemplified embodiments which are intended as illustrations of single aspects of the invention, ~~and any clones, DNA or amino acid sequences which are functionally equivalent are within the scope of the invention.~~ Indeed, various modifications of the invention in addition to those described herein will become apparent to those skilled in the art from the foregoing description ~~and accompanying drawings.~~ Such modifications are intended to fall within the scope of the appended claims.